

REMARKS

Status of the claims

Claims 1-8 are pending and claims 1, 5, and 7-8 are under consideration in this application, claims 2-4 and 6 having been withdrawn on the ground that there is allegedly no allowable generic or linking claim. The amendment to step (c) of claim 1 and new claims 9-16 are supported by the specification, e.g., at page 24, lines 7-15, and page 27, lines 7-25 and claims 1-8 as originally filed in parent U.S. Application Serial No. 10/032,786.

None of the amendments made herein add new matter.

After entry of the amendments made herein, claims 1-16 will be pending and claims 1, 5, and 7-16 will be under consideration in this application.

In the Response to Restriction Requirement filed August 17, 2006, Applicant did not traverse the group or species restriction requirement. Thus, Applicant respectfully requests clarification of the following recitation in the Office Action:

Because applicant did not distinctly and specifically point out the supposed errors in the Group or species restriction requirement, the restriction requirement is deemed proper and therefore made final (MPEP § 818).

Priority

Applicant thanks the Examiner for pointing out the typographical error in the amendment made to the specification on December 11, 2003, to insert the priority claim for the present application. The above amendment to the specification serves to correct this inadvertent error.

35 U.S.C. § 112, second paragraph, rejection

Claims 1, 5, and 7-8 stand rejected as allegedly being incomplete for omitting essential steps.

From the comments on page 3, lines 5-11, of the Office Action, Applicant understands the Examiner's position to be that, because step (d) does not iterate the preamble of the claim, there is an omitted step in claim 1 that amounts to a gap between steps. While disagreeing that there is a step missing from claim 1, in the interest of enhanced clarity, Applicant has amended

claim 1 by adding an explanatory clause that states "wherein a test compound that inhibits binding of the MUC1 test agent to a tumor progressor test agent is a compound that inhibits binding of MUC1 to a tumor progressor." Applicant respectfully submits that this amendment, which is supported by the specification (e.g., at 20, line 2, to page 26, line 11) and adds no new matter, renders the rejection moot.

35 U.S.C. § 102(b) rejections

(a) Claims 1, 5, and 7 stand rejected as allegedly being anticipated by Yamamoto et al.

From the comments on page 3, line 17, to page 4, line 5, of the Office Action, Applicant understands the Examiner's position to be that the experiment described in Yamamoto et al. on page 12493 and Figure 3 anticipates claim 1, 5, and 7. While not necessarily agreeing with this position, Applicant submits that the above amendment to step (c) of claim 1 renders the rejection moot.

(b) Claims 1, 5, and 8 stand rejected as allegedly being anticipated by Li et al.

From the comments on page 4, lines 8-17, of the Office Action, Applicant understands the Examiner's position to be that the experiment described in Li et al. on page 7219 and 7220 and Figure 5 anticipates claims 1, 5, and 8. While not necessarily agreeing with this position, Applicant submits that the above amendment to step (c) of claim 1 renders the rejection moot.

CONCLUSION

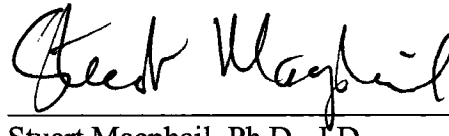
In summary, for the reasons set forth above, Applicants maintain that the pending claims patentably define the invention. Applicants request that the Examiner reconsider the rejections as set forth in the Office Action, and permit the pending claims to pass to allowance.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' undersigned representative can be reached at the telephone number listed above

Enclosed is a request for an automatic extension of time. Please apply the charge for the extension of time and any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 00530-095002.

Respectfully submitted,

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